

### **REMARKS**

By this amendment, claims 1-6, 32, and 34 have been amended. Claims 1-6, 32, and 34 are pending in the application. Applicants reserve the right to pursue the original claims and other claims in this and other applications. Applicants note that the Office Action Summary indicates that the Office Action is responsive to a communication filed 2/23/04 and claims 1-34 are pending in the application. However, there have been multiple Office Action responses, including an Amendment filed on October 21, 2009, and claims 7-31 and 33 were previously canceled.

Claims 1-6, 32, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nonomura (US 2003/0108338) in view of Baldwin et al. (US 6,975,363). This rejection is respectfully traversed. Neither Nonomura nor Baldwin et al., even when considered in combination, teaches or suggests all of the features of independent claims 1, 32, or 34.

Claim 1 recites a decoding apparatus comprising, *inter alia*, “a pickup configured to read mainstream packet data and sub-audio packet data corresponding to the mainstream packet data from the optical disc; a mainstream decoder configured to decode the mainstream packet data; a sub-audio decoder configured to decode the sub-audio packet data, a mainstream system time clock counter ... used for decoding the mainstream packet data ...; and a sub-audio system time clock counter ... used for decoding the sub-audio packet data ... and is independent of the system time clock sequence of the mainstream system time clock counter, ... wherein the sub-audio system time clock counter continuously increases even if a user inputs a reverse play or

forward play command” (emphasis added). Claims 32 and 34 recite similar features. Claims 1 and 34 have been amended to further clarify that the “sub-audio packet data correspond[s] to the mainstream packet data,” which was argued in the previous Amendment. Claim 32 has been amended to clarify that the “audio data correspond[s] to the video data,” as was also previously argued. Applicants respectfully submit that Nonomura and Baldwin et al., even when combined, fail to teach or suggest at least these features.

Baldwin et al. was cited for teaching the separate clocks and that the sub-audio system time clock counter continuously increases even if a user inputs a reverse play or forward play command. To the contrary, Baldwin et al. actually teaches, as the Office Action admits at page 4, that “a viewer might watch a football game, but instead of listening to the accompanying football commentary, the viewer may listen to the local news. In addition, the viewer may listen to broadcasts having different sampling rates that a television broadcast such as, for example, music broadcasted from a compact disc source.” Col. 7, ln. 67 – Col. 8, ln. 5 (emphasis added). The audio of Baldwin et al. in this circumstance does not correspond to the video.

The premise upon which the Office Action bases the argument of inherency is thus inapplicable. Baldwin et al. does not address the operation of the audio clock and the video clock with respect to forward and reverse play commands. Thus, in the context of mainstream packet data and sub-audio packet data corresponding to the mainstream packet data, a person of ordinary skill in the art would expect that the sub-audio system time clock would reverse if a forward play command were input. The Office Action assumes that Baldwin et al. provides for forward and reverse play commands, but Baldwin et al. only discusses television broadcasts for a video source, which have no reverse play and are not user-controllable. Baldwin et al. is directed

toward “digital audio/video signal receivers,” i.e., television sets. Col. 1, ln. 8-9 (emphasis added). Baldwin et al. presents no disclosure as to a reason to expect that the audio would not follow the play direction of the video, and the Office Action has not presented any additional evidence as to a reason why the person of ordinary skill in the art would modify the disclosures of the Nonomura and Baldwin et al. references in the manner proposed.

In order to show inherency, the Office Action must show “that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. ... The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *See* M.P.E.P. § 2112(IV). In this case, the disclosure of Baldwin et al. is insufficient to show that the sub-audio time clock necessarily continues to increase. It is just as likely that the audio clock would be adjusted in correspondence with the command, since the person of ordinary skill in the art would understand that the sub-audio packet data corresponds to the mainstream packet data. Since Baldwin et al. does not necessarily disclose that the sub-audio system time clock continues to increase even when a forward play or reverse play command is input, the Office Action cannot rely upon an inherency argument.

Applicants respectfully submit that Baldwin et al. does not disclose, teach, or suggest “sub-audio packet data corresponding to the mainstream packet data . . . ; a mainstream system time clock counter . . . used for decoding the mainstream packet data . . . ; and a sub-audio system time clock counter . . . [,] wherein the sub-audio system time clock counter continuously increases even if a user inputs a reverse play or forward play command,” as recited in claim 1 and the similar features recited in claim 34. Nor does Baldwin et al. disclose, teach, or suggest

audio data corresponding to the video data, a first system time clock for video data, and a second system time clock for audio data that is independent of the first system time clock, wherein the second system time clock counter continuously increases even if the forward play or the reverse play is selected, as recited in claim 32.

The Office Action admits at page 3 that Nonomura fails to teach these features. Thus, Nonomura does not remedy the deficiencies of Baldwin et al.

Since Nonomura and Baldwin et al. do not teach or suggest all of the features of claims 1, 32, and 34, claims 1, 32, and 34 are not obvious over the cited combination. Claims 2-6 depend from independent claim 1 and are patentable at least for the reasons mentioned above, and on their own merits. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 1-6, 32, and 34 be withdrawn and the claims allowed.

Claims 1-6, 32, and 34 have been further amended to correct grammatical and typographical errors unrelated to any rejection in the Office Action, and should not require further consideration or search.

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: March 29, 2010

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